

REMARKS

This is a response to the Office Action mailed on June 16, 2008. Claims 1, 3-8, and 10 are presented for examination.

Claim Rejections Under 35 U.S.C. § 102/103

Claims 1, 3-6, 8, and 10 were rejected under 35 U.S.C. § 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over EP1093160 (Suga). Applicants respectfully disagree.

It is well settled that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in ... [the] claim.” Manual of Patent Examining Procedure (MPEP) § 2131 (8th ed., October 2005); and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In *KSR International Co. v. Teleflex Inc.*, the U.S. Supreme Court rejected the Federal Circuit's *rigid application* of the "teaching, suggestion, motivation" test (“the TSM test”) in determining obviousness in the particular case in question. 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385, 1395 (2007) (emphasis added). According to the Supreme Court, the correct analysis is set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966). *Id.* However, the *KSR* decision indicated that while the TSM test is not the sole method for determining obviousness, it may still be used and in some cases is helpful. *Id.* at 1396. (“When it first established [the TSM test], the Court...captured a helpful insight.”). Indeed, the guidelines for the examination of patents in the wake of the *KSR* decision make clear that an Examiner may still apply the TSM test, after resolution of the *Graham* analysis. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528 (Oct. 10, 2007) (“USPTO Guidelines”).

The *Graham* factual inquiries are: (1) determine the scope and contents of the prior art; (2) ascertain the differences between the prior art and the claims at issue; (3) resolve the level of ordinary skill in the pertinent art; and (4) evaluate any evidence of secondary considerations. *KSR*, 82 U.S.P.Q.2d at 1395 (citing *Graham*, 383 U.S. at 15-17). Once the

Graham factors have been addressed, the Examiner may apply the TSM test, asking whether (1) a teaching, suggestion or motivation exists in the prior art to combine the references cited, and (2) one skilled in the art would have a reasonable expectation of success. *See* USPTO Guidelines at 57534.

The *Graham* factual inquiries begin with an analysis of the scope and content of the prior art, in view of the scope of the claimed invention. *See* USPTO Guidelines at 57527 (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)).

Claim 1 recites:

1. An anisotropic-electroconductive adhesive comprising:
 - an insulating adhesive component containing a radical polymerizable compound and a polymerization initiator; and
 - a plurality of insulating coated electroconductive particles dispersed in the insulating adhesive component, the insulating coated electroconductive particle having a coating layer made of insulating thermoplastic resin on a surface of an electroconductive particle,
 - wherein an exothermic peak temperature of the insulating adhesive component is in the range of 80°C~120°C and a softening point of the insulating thermoplastic resin is lower than the exothermic peak temperature of the insulating adhesive component.

Claim 1 requires that the insulating adhesive component have an exothermic peak temperature in the range of 80°C to 120°C, and that the electroconductive particles dispersed in the insulating adhesive component be coated with an insulating thermoplastic resin having a lower softening point than this exothermic peak temperature.

As explained in the specification, the significance of the temperature range is that an exothermic peak temperature exceeding 120°C cannot ensure rapid curing, and an exothermic peak temperature lower than 80°C leads to problems with storage of the material. Also, if the softening point of the insulating thermoplastic resin is higher than the exothermic peak temperature (80°C to 120°C) of the insulating adhesive component, the insulating adhesive component would be cured before the coating layer is softened, thereby preventing removal of the coating layer and making it impossible to use the inventive anisotropic electroconductive adhesive in the desired application of forming electrical circuit connections.

Suga does not disclose the claimed relationship between the exothermic peak temperature of an insulating adhesive component and the softening point of an insulating thermoplastic resin coated on an electroconductive particle.

In fact, Suga does not disclose an exothermic peak temperature at all. Instead, Suga discloses a curing initiation temperature. The curing initiation temperature is the temperature at which curing is initiated. The exothermic peak temperature, by contrast, is the temperature at which the curing reaction is most actively occurring.

Because Suga fails to disclose or teach all the elements of claim 1, Suga cannot anticipate claim 1, and the §102(b) rejection of claim 1 should therefore be withdrawn.

The purported alternative rejection of claim 1 in the last sentence of page 3 of the Office action is nothing more than a conclusory statement that one aspect of the invention is obvious. In making this statement, the Examiner fails to follow the analysis of *Graham v. John Deere* or any other recognized mode of obviousness analysis, and fails to make a *prima facie* case that claim 1 is obvious in view of Suga. The alternative rejection of claim 1 under §103(c) over Suga should therefore be withdrawn.

Because claims 3-6, 8, and 10 are dependent claims depending from claim 1, the rejections of these claims should also be withdrawn, for at least this reason.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 3-8, and 10 were rejected under 35 U.S.C. § 103(a) as obvious over Suga in view of U.S. 6,158,115 (Tsukagoshi). The claims were also rejected as obvious over Tsukagoshi in view of Suga. Applicants respectfully disagree.

It is true that Tsukagoshi at col. 10, ll. 55-67 discloses an exothermic peak temperature in the range of 50 to 150°C. However, Applicants in claim 1 recite a narrower range of 80°C to 120°C, and have explained above the significance of this range. Further, neither Suga nor Tsukagoshi discloses, teaches, or suggests the relationship between the exothermic peak temperature of the insulating adhesive component and the softening point of the insulating thermoplastic resin coated on conductive particles as recited in claim 1.

Because neither Suga nor Tsukagoshi, alone or in combination, teach, disclose, or suggest all the limitations of claim 1, claim 1 is not obvious over these references, and the rejections of claim 1 under 35 U.S.C. § 103(a) should be withdrawn. Because claims 3-8 and

10 are dependent directly or indirectly from claim 1, they are also patentable over the references, and the rejections of these claims should also be withdrawn.

Conclusion

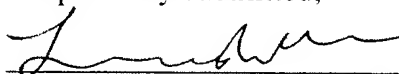
In view of the above, applicants respectfully submit that the present application is in condition for allowance. A favorable disposition to that effect is respectfully requested.

No fees are believed to be due with this submission, other than the fee for a one-month extension of time requested in the Petition submitted herewith. Please charge any fee that may be due or credit any overpayment to Jones Day Deposit Account No. 50-3013.

Should the Examiner have any questions or comments concerning this submission, he is invited to call the undersigned at the phone number listed below.

Date: October 15, 2008

Respectfully submitted,



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